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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------------------|------------------|
| 09/291,245 | 04/13/1999 | CARY LEE BATES | R0998-223 | 1843 |
| 7590 01/12/2005 JOAN PENNINGTON 535 NORTH MICHIGAN AVENUE UNIT 1804 CHICAGO, IL 60611 | | | EXAMINER EBRAHIMI DEHKORDY, SAEID | |
| | | | ART UNIT 2626 | PAPER NUMBER |

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/291,245

Applicant(s)

BATES ET AL.

Examiner

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14, 15, 17 and 18 is/are allowed.
- 6) ☐ Claim(s) 1-13 and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed on 7/26/04 have been fully considered but they are not persuasive. The applicant on page 10 line 22 and page 11 line 1 argues that Nielsen fails to disclose and provide no suggestion of a stored document print index.
2. Examiner disagrees and points out Nielsen column 2 lines 7-10 where the Nielsen allows the originator or author to arrange the storage of the individuals hyperspecial document which can be stored in multiple directories in the servers. Examiner also points out Nielsen, column 3 lines 25-34 where the URLs where stored. Also on column 5 lines 31-52 storage of the web pages are explained.
3. Applicant argues on page 11 lines 2-7 that Nielsen fails to disclose the print index is that is explicitly specified by a web based document originator and further recite the step of identifying uniform resource locators (URLs).
4. Examiner disagrees and points out the Nielsen column 1 lines 62-67 and column 2 lines 1-6 and specifically column 3 lines 12-33 where the web pages are tagged and chosen to be printed, Also note column 2 lines 7-14 and also column 3 lines 19-24 where the originator or in this case Author is arranging the web pages and URLs.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-13,16,19-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Nielsen (U.S. patent 5,991,514)

Regarding claim 1 Nielsen discloses: A method for implementing web based document printing comprising the steps of:

Obtaining a print index (please note column 1 lines 62-67 and column 2 lines 1-6 and specially column 3 lines 12-33 where the web pages are tagged and chosen to be printed) said print index explicitly specified by a web based document originator identifying uniform resource locators (URLs) in said print index (please note column 2 lines 7-14 and also column 3 lines 19-24 where the author is arranging the web pages and URL) sequentially printing said URLs in said print index (please note column 2 lines 4-7 and also column 3 lines 19-26).

Regarding claim 2 Nielsen discloses: The method for implementing web based document printing as recited in claim 1 further includes the step of checking for a user selection of confirm print index option, and responsive to identifying said user selection of confirm print index option performing a display and edit print index routine (please note column 3 lines 54-61).

Regarding claim 3 Nielsen discloses: The method for implementing web based document printing as recited in claim 1 wherein the step of obtaining said print index includes the steps of checking for a user selection of whole print option and responsive

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to identifying said user selection of whole print option checking for a root tag present in the current page (please note column 4 lines 56-67 and column 5 lines 1-8).

Regarding claim 4 Nielsen discloses: The method for implementing web based document printing as recited in claim 3 includes the steps of responsive to identifying said root tag present in the current page switching to said root tag for printing (please note column 3 lines 35-41).

Regarding claim 5 Nielsen discloses: The method for implementing web based document printing as recited in claim 1 wherein the step of obtaining said print index includes the steps of obtaining a kind of multi print to perform (please note column 2 lines 1-16).

Regarding claim 6 Nielsen discloses: The method for implementing web based document printing as recited in claim 5 includes the steps of checking for a user selection of honor HTML responsive to identifying said user selection of honor HTML checking for a print index in the current page (please note column 3 lines 54-61).

Regarding claim 7 Nielsen discloses: The method for implementing web based document printing as recited in claim 6 includes the steps of responsive to said print index in the current page returning said print index (please note column 4 lines 41-44).

Regarding claim 8 Nielsen discloses: The method for implementing web based document printing as recited in claim 6 includes the steps of checking for a user selection of print equal yes and anchor tags present in the current page and responsive to identifying said user selection of print equal yes and anchor tags present in the current page returning scattered print (please note column 3 lines 11-33).

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Regarding claim 9 Nielsen discloses: The method for implementing web based document printing as recited in claim 8 includes the steps of responsive to not identifying said user selection of print equal yes and anchor tags present in the current page returning only current page print (please note column 3 lines 25-33).

Regarding claim 10 Nielsen discloses: The method for implementing web based document printing as recited in claim 6 includes the steps of responsive to not identifying said user selection of honor HTML checking for a user selection of print index (please note column 3 lines 54-61).

Regarding claim 11 Nielsen discloses: The method for implementing web based document printing as recited in claim 10 includes the steps of responsive to identifying said user selection of print index checking for a print index present in the current page (please note column 3 lines 54-67 and column 4 lines 1-3).

Regarding claim 12 Nielsen discloses: The method for implementing web based document printing as recited in claim 11 includes the steps of responsive to identifying said print index present in the current page returning said print index (please note column 4 lines 14-22).

Regarding claim 13 Nielsen discloses: The method for implementing web based document printing as recited in claim 12 includes the steps of responsive to identifying said print index present in the current page returning only current page print (please note column 3 lines 12-24).

Regarding claim 16 Nielsen discloses: the method of implementing web based document printing as recited in claim 5 includes the step of checking for an existing print

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index and responsive to identifying said existing print index returning said existing print index (please note column 3 lines 54-67 and column 4 lines 1-3).

Regarding claim 19 Nielsen discloses: the method for implementing web based document printing as recited in claim 5 includes the step of creating a print index containing only the current page (please note column 3 lines 11-17).

Regarding claim 20 Nielsen discloses: The method for implementing web based document printing as recited in claim 1 includes the steps of identifying a user selection of level first and creating a print index to print highest level orders first (please note column 4 lines 41-45).

Regarding claim 21 Nielsen discloses: The method for implementing web based document printing as recited in claim 1 includes the steps of identifying a user selection of branch first and creating a print index to sequentially print each branch (please note column 3 lines 11-18).

Regarding claim 22 and 25 Nielsen discloses: Apparatus for implementing web based document-printing comprising:
a stored document print index (please note column 3 lines 25-33) said print index explicitly specified by a web based document originator (please note column 3 lines 19-28) said document print index including a list of user selected uniform resource locators (URLs) to be printed (please note column 3 lines 54-67 and column 4 lines 1-3) and a web based printing program utilizing said stored document print index for printing a document including said list of user selected uniform resource locators (URLs) (please note column 2 lines 2-7 and also column 3 lines 12-23).

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Regarding claim 23 Nielsen discloses: Apparatus for implementing web based document printing as recited in claim 22 includes a scattered print specification said scattered print specification including a URL print control function with HTML elements (please note column 4 lines 56-67 and column 5 lines 1-8).

Regarding claim 24 Nielsen discloses: Apparatus for implementing web based document printing as recited in claim 23 includes a print order number and a print order control (please note column 5 lines 11-20).

Regarding claim 26 Nielsen discloses: The computer program product implementing web based document printing as recited in claim 25 includes means, recorded on the recording medium for identifying a user selected scattered print specification and means recorded on the recording medium, for identifying URLs with HTML elements having anchor tags of a user selection of print equals yes and for printing a document including said URLs with HTML elements having anchor tags of said user selection of print equals yes (please note column 3 lines 12-33).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark
"EXPEDITED PROCEDURE")

Or:

(703) 306-5406 (for **informal** or **draft** communications, please label
"PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

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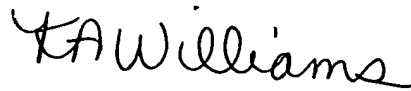
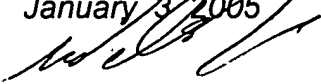
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Saeid Ebrahimi-Dehkordy

Patent Examiner

Group Art Unit 2626

January 3, 2005



KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER